

REMARKS

In response to the Office Action mailed October 21, 2003, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the remarks contained herein place the instant application in condition for allowance and therefore, respectfully request that the rejections associated with the pending claims be withdrawn

Claims 1, 5-11,13-14 and 16-20

In the Office Action, claims 1, 5-11, 18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,852,775 ("Hidary") in view of U.S. Patent No. 6,505,046 ("Baker") and U.S. Patent No. 5,875,401 ("Rochkind"). In addition, claims 13-14, 16-17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hidary in view of Rochkind. Applicants traverse the rejections as follows.

Applicants submit that claims 1 and 13 are not obvious over Hidary, Baker, and Rochkind because none of these references, alone or in combination, disclose, teach or suggest all the limitations set forth in the claims. In addition, Applicants also respectfully submit that no motivation or suggestion exists, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the teachings of the references to arrive at the subject matter claimed in claims 1 and 13.

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim. *See MPEP §2142*. Furthermore, the teachings or suggestions must be found in the cited references and cannot be based on the Applicants' disclosure. *See MPEP §§2143-2143.03*. Applicants submit that the Office has not established a *prima facie* case of obviousness because not all

elements of claims 1 and 13 are taught or suggested by the cited references alone or in combination.

Hidary is directed to a cellular telephone system that involves an ad server and a memory for holding various commercial messages that are generic or tailored for specific demographically selected subscribers or geographic cells. *See Hidary, col.2; line 15 - col. 4; line 54.* However, Applicants submit, as was stated on page 2 of the Office Action, that nowhere does Hidary teach, among other things, “sending one of the plurality of user-specific advertisements to the wireless communication device... without transmitting... the location of the user therewith and the plurality of location-specific advertisements to the wireless communication device... without transmitting... the identity of the user therewith” as claimed in claims 1 and 13.

Baker is directed to a network that processes a mobility origination message, derives the subscriber’s location and constructs a set of advertisements based on that location for a subscriber at a particular time. *See Baker, col.2; lines 8-27.* However, Applicants submit that nowhere does Baker teach, among other things, “sending one of the plurality of user-specific advertisements to the wireless communication device... without transmitting... the location of the user therewith and the plurality of location-specific advertisements to the wireless communication device... without transmitting... the identity of the user therewith” as claimed in claims 1 and 13.

The Rochkind reference is also of no aid to the Office in this regard. The Rochkind reference involves sending a message to a subscriber so that the subscriber can be certain of both the location from which the message originates and the identity of the sender such as in the case of a parent monitoring the after-school activities of his/her child. *See Rochkind, col.1; lines 10-*

50. By necessary implication, therefore, Rochkind also fails to teach or suggest, among other things, “sending one of the plurality of user-specific advertisements to the wireless communication device... without transmitting... the location of the user therewith and the plurality of location-specific advertisements to the wireless communication device... without transmitting... the identity of the user therewith” as claimed in claims 1 and 13. (emphasis added).

On page 3 of the Office Action, the Office states that Rochkind “teaches sending a user and location specific message to a wireless communication device without transmitting an indication of the location or identity of the user.” *See Rochkind, col.6; lines 34-40*. Applicants respectfully submit that the Rochkind reference is taken out of context because such an embodiment would render the design disclosed in Rochkind useless for its intended purpose of monitoring the identity and location of the sender.

Applicants further note that Rochkind states that “it may be desired to transmit a message [e.g., stating that the child is not in a particular location] only when the proper identification information and location information are not received...within a specified time window.” *See Rochkind, col.6; lines 37-40. (emphasis added)*. Such a disclosure not only directly contradicts claims 1 and 13, but also does not teach or suggest all the limitations set forth in claims 1 and 13, namely “receiving first information about the identity of the user; receiving second information about the location of the user” and sending an advertisement to a wireless communication device without transmitting an indication of the location or identity of the user. In short, Rochkind discloses sending a message without transmitting the identity and location of the user only if information regarding the identity and location of the user are not received, whereas the claims of

the present invention involve sending a message without transmitting the identity and location of the user even though information concerning the identity and location is received.

Therefore, Applicants respectfully submit that claims 1 and 13 are not obvious in view of Hidary, Baker and Rochkind taken alone or in combination, because not all elements of claims 1 and 13 are taught or suggested by the cited references. Thus, Applicants submit that claims 3-12, which depend from claim 1, and claims 14-20, which depend from claim 13, are not obvious in view of the cited references for the same reasons stated hereinabove.

Although Applicants need not reach it, Applicants submit that even if the combination of the references teach or suggest every element of the claimed invention, without motivation to combine the cited references, a rejection based on obviousness is improper. *See MPEP §2142*. There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. Furthermore, the level of skill in the art, alone, cannot be solely relied upon to provide the suggestion to combine references. *See MPEP §2143.01*. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the reference teachings. *See MPEP §2142*.

Accordingly, the nature of the problems solved by the Hidary, Baker, and Rochkind references must be considered and then the nature of these problems must be compared with the nature of the problems solved by the claimed invention taken as a whole. As previously stated, Hidary is directed to a cellular telephone system that involves an ad server and a memory for holding various commercial messages that are generic or tailored for specific demographically

selected subscribers or geographic cells; Baker is directed to a network that processes a mobility origination message, derives the subscriber's location and constructs a set of advertisements based on that location for a subscriber at a particular time; and Rochkind involves sending a message to a subscriber so that the subscriber can be certain of both the location and the identity of the sender. However, Hidary, Baker, and Rochkind are completely devoid of any teaching, suggestion, or motivation of "receiving first information about the identity of the user; receiving second information about the location of the user" and sending an advertisement to a wireless communication device without transmitting an indication of the location or identity of the user as claimed in claims 1 and 13.

Unlike Hidary, Baker, and Rochkind, one advantage of the claimed invention is sending an advertisement to a wireless communication device without transmitting an indication of the location or identity of the user despite receiving information concerning the identity and location of the user. Thus, when considering the nature of the problems solved by the cited references in light of the nature of the problems solved by the claimed invention as a whole, one could reasonably conclude that no motivation exists to combine Hidary, Baker, and Rochkind to arrive at the claimed invention.

Furthermore, to establish a *prima facie* case of obviousness, all of the teachings of the prior art references must be considered, even disclosures that teach away from the claimed invention. *MPEP* §2141.02. In addition, to establish a *prima facie* case of obviousness the proposed combination of prior art references cannot change the principle of operation of the prior art device being modified nor can the proposed combination render the prior art device being modified unsatisfactory for its intended purpose. *See MPEP* 2143.01. Therefore, Applicants submit that there is no motivation or suggestion for one of ordinary skill in the art to combine the

teachings of the cited references to arrive at the claimed invention because the Rochkind reference implicitly teaches away from concealing the location and identity of the sender because nondisclosure of the location and identity of sender would render the device unsatisfactory for its intended purpose of informing the subscriber of the exact identity and location of the individual sending the message. *See Rochkind, col.1; lines 10-50.*

Although Applicants reassert that combining Hidary, Baker, and Rochkind to arrive at the claimed invention would change both the principle of operation of Rochkind as well as destroy Rochkind's intended function, Applicants submit that just because the cited references can be combined or modified is not sufficient to establish a prima facie case of obviousness. *MPEP §2143.01*. Even the argument that combining Hidary, Baker, and Rochkind is merely a simple solution that the claimed invention embodies is not enough to make a determination of obviousness without a finding as to the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to receive information about the identity of the user, receive information about the location of the user and send an advertisement to a wireless communication device without transmitting an indication of the location or identity of the user as claimed in claims 1 and 13. *See MPEP 2143.01.*

Furthermore, to reach a proper determination under 35 U.S.C. §103, the Office must step backward in time to a point just before the claimed invention was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to a person of ordinary skill in the art. Although the tendency to resort to "hindsight" based upon Applicant's disclosure is often difficult, impermissible hindsight must be avoided. The Examiner must put aside the knowledge of the Applicant's disclosure in reaching a determination of obviousness and this legal conclusion must

be reached on the basis of the facts gleaned from the prior art and not from the Applicant's disclosure. *See MPEP §2142.*

Without the disclosure of the Applicants' claimed invention, Applicants submit that one of ordinary skill in the art would not have, at the time the invention was made, considered combining Hidary, Baker, and Rochkind to arrive at the claimed invention because Hidary, Baker, and Rochkind do not explicitly or implicitly suggest to one of ordinary skill in the art to combine the reference teachings. In fact, Rochkind implicitly teaches away from the technology disclosed in the claimed invention and to combine Hidary, Baker, and Rochkind to arrive at the claimed invention would not only change the principle operation of Rochkind, but also would destroy Rochkind's intended function for reasons stated hereinabove.

Therefore, Applicants respectfully submit that claims 1 and 13 are not obvious in view of Hidary, Baker, and Rochkind, taken alone or in combination, because none of the cited references teach, suggest, or motivate an artisan to combine the cited references to arrive at an invention that receives information about the identity of the user, receives information about the location of the user and sends an advertisement to a wireless communication device without transmitting an indication of the location or identity of the user. Thus, Applicants submit that claims 3-12, which depend from claim 1, and claims 14-20, which depend from claim 13, are not obvious in view of the cited references for the same reasons stated hereinabove.

Claims 3-4, 12, and 15

In the Office Action, claims 3-4, 12, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hidary in view of Baker, Rochkind and U.S. Patent No. 6,101,381 ("Tajima"). Applicants traverse the rejection as follows.

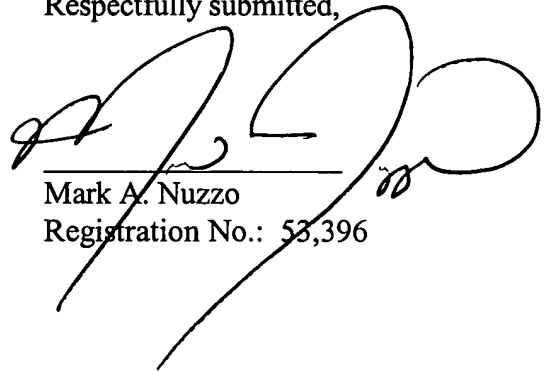
Claims 3-4 and 12 depend from independent claim 1 and claim 15 depends from independent claim 13. For reasons stated hereinabove, Applicants submit that claims 1 and 13 are not obvious over Hidary, Baker and Rochkind. In addition, MPEP §2143.03 states that if an independent claim is not obvious under 35 U.S.C. §103(a), then any claim depending therefrom is not obvious over the cited references. *See MPEP §2143.03*. Therefore, Applicants submit that claims 3-4 and 12, which depend from claim 1, and claim 15, which depends from claim 13, are not obvious in view of Hidary, Baker, Rochkind and Tajima for reasons stated hereinabove. Accordingly, Applicants respectfully request that the §103(a) rejections associated with claims 3-4, 12, and 15 be withdrawn.



CONCLUSION

Applicants respectfully request issuance of a Notice of Allowance for the pending claims in this application. If the Examiner is of the opinion that the instant application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



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